

Remarks

Claims 29-32, 34, 35, 37, 40-46, and 48 are pending in the application.

Applicant requests the Examiner reevaluate the rejections of the pending claims in view of the following remarks.

Claims 44, 45 and 48 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nakamura (U.S. Patent No. 6,232,629).

The pending claims are anticipated "only if each and every element as set forth in the claims are found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Each and every element as set forth in claims 44, 45, and 48 are not expressly or inherently described in the Nakamura reference.

For example, claim 44 recites a capacitor wherein at least one of the first and second capacitor electrodes comprises a roughened platinum layer, the roughened platinum layer having a continuous surface characterized by columnar platinum pedestals having heights greater than or equal to about one-third of a total thickness of the platinum layer, the platinum pedestals terminating in dome-shaped tops. While Nakamura does describe a roughened platinum layer, the layer having a continuous surface is not characterized by columnar platinum pedestals having heights greater than or equal to about one-third of a total thickness of the platinum layer. Likewise, the embodiment that may be characterized by columnar

platinum pedestals having heights greater than or equal to about one-third of a total thickness of the platinum layer, does not have a continuous surface.

Figs. 2, 8, and 26 of Nakamura depict a plurality of individual columns of platinum, not the continuous layer characterized by pedestals as recited in claim 44. For at least this reason, claim 44 is allowable. Claims 45 and 48 depending therefrom are allowable for at least these reasons as well as their own patentable features.

Claims 29-32, 34, 35, 37, 40-43 and 46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura (U.S. Patent No. 6,232,629) in view of Aoki et al. (U.S. Patent No. 6,033,953).

Initially, an Examiner bears the burden of factually supporting any conclusion of obviousness. The Applicants need not submit any evidence of non-obviousness until the Examiner produces a prima facie case that the claims are obvious. To establish a prima facie case, all of the claimed limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580, 582-3 (CCPA 1974). Either alone or in combination, Nakamura and/or Aoki fail to teach all the limitations of claims 29-32, 34, 35, 37, 40-43 and 46.

As stated above, Nakamura fails to teach **a roughened platinum layer having a continuous surface characterized by columnar platinum pedestals having heights greater than or equal to about one-third of a total thickness of the platinum layer**, and Aoki does not cure this failure. Therefore, a prima facie case of obviousness cannot be established with regard to claims 29-32, 34, 35, 37, 40-43 and 46 based on these references.

Applicant requests allowance of claims 29-32, 34, 35, 37, 40-46, and 48 in the Examiner's next action. If the Examiner's next action is to be anything other than a Notice of Allowance, the Applicant respectfully requests a telephone interview prior to issuance of any such subsequent action. The undersigned is available for telephone consultation at (509) 624-4276 Monday through Friday, 8:00 a.m.-5:00 p.m. (PST).

Respectfully submitted,

Dated: 1/8/08

By: 

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